

REMARKS

This responds to the Office Action mailed on January 12, 2005.

Claims 1, 6, 10-12, 17, 20 and 23 have been amended, no claims have been added and no claims have been canceled. Thus, claims 1, 2, and 4-26 are now pending in this application.

§102 Rejection of the Claims

Claims 1-8, 10-11, 14-20, and 22-26 were rejected under 35 USC § 102(e) as being anticipated by Deao et al. (U.S. 6,065,106).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

The Office Action mailed January 12, 2005 incorporates by reference the Office Action mailed November 1, 2004, which in turn incorporates by reference, the Office Action mailed September 4, 2003.

In rejecting independent claim 1, the Office Action mailed September 4, 2003 asserted Deao’s processor (see figure 45, elements 4516, 4518, 4520, and 4522, column 51, line 50-column 52, line 30) anticipates the claimed processor. Applicant submitted that Deao’s figure 45 (see block 4520) shows that a software breakpoint is required for triggering each additional

emulation event. In response to Applicant's submission, the Office Action mailed January 12, 2005 stated, "nothing in the claims require that the single replay indicator received is the only indicator necessary for the processor being completely configured to test itself by repeatedly executing a plurality of instructions." Office Action mailed January 12, 2005 at page 4, section 12. Applicant has amended independent claim 1 to recite "wherein the processor does not require receipt of another replay indicator to repeatedly execute the plurality of instructions." For at least this reason, Applicant respectfully submits claim 1 is patentably distinct over Deao.

Rejected independent claims 6, 10, 17, 20, and 23 include features similar to that noted in the discussion of claim 1. Specifically, these claims include the following.

- Independent claim 6 recites "wherein the processor is capable of repeatedly replaying the at least one execution without receipt of another replay break."
- Independent claim 10 recites "wherein the processor is capable of repeatedly replaying the at least one execution without generation of another signal to cause the processor to load the replay handler into the memory hierarchy."
- Independent claim 17 recites "wherein the repeated execution of the replay kernel does not require receipt of another replay signal."
- Independent claim 20 recites "wherein the replaying the system execution a number of times does not require responding to another replay break."
- Independent claim 23 recites "wherein the repeatedly replaying the at least one execution does not require the receipt of another replay break."

Dependent claims 2, 4, 5, 7, 8, 11, 14-16, 18, 19, 22, and 24-26 each depend, directly or indirectly on one of independent claims 1, 6, 10, 17, 20, or 23. As such, dependent claims 2, 4, 5, 7, 8, 11, 14-16, 18, 19, 22, and 24-26 each include the features of the claims on which they

depend. For at least the reasons noted above, Applicant respectfully submits that Deao does not teach each and every element of claims 1, 2, 4-8, 10, 11, 14-20, and 22-26.

§103 Rejection of the Claims

Claims 9, 12, 13, and 21 were rejected under 35 USC § 103(a) as being unpatentable over Deao et al. (U.S. 6,065,106).

The Examiner rejected claims 9, 12, 13, and 21 based on Deao. Dependent claims 9, 12, 13, and 21 each depend directly or indirectly from one of independent claims 6, 10, and 20. Because the rejection under 35 USC §103 does not add any teaching or suggestion to Deao, Applicant respectfully submits that dependent claims 9, 12, 13, and 21 are patentable over Deao for at least the reasons discussed above, with reference to claims 6, 10, and 20.

Reservation of Rights

Applicant does not admit that patents cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such patents should not be construed as admissions that they are prior art.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Andrew DeLizio at (281)-213-8980, or Applicant's below-named representative to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

KIRAN A. PADWEKAR

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 349-9592

Date April 12, 2005

By Ann M. McCrackin
Ann M. McCrackin
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12th day of April, 2005.

Dennis J. Kaph

Name

[Signature]

Signature